

## REMARKS

In the Office Action, the Examiner rejected Claims 1-15, which were all of the then pending claims, under 35 U.S.C. 103 as being unpatentable over the prior art. More specifically, Claims 1-5 and 10-15 were rejected as being unpatentable over U.S. Patent 6,073,138 (de l'Etraz, et al.) in view of U.S. Patent application publication no. 2002/0095298 (Ewing); and Claims 6-9 were rejected as being unpatentable over de l'Etraz, et al. in view of Ewing and further in view of U.S. Patent 6,014,634 (Scroggie, et al.). The Examiner also objected to an informality in Claim 1.

Independent Claim 1 is being amended to better define the subject matter of the claim. Claim 3 is being cancelled to reduce the number of issues in this application, and Claim 46, which is dependent from Claim 1, is being added to describe optional features of an embodiment of the invention.

These amendments address the Examiner's objection to Claim 1. In particular, the Examiner noted that, while the specification indicates that the records emanate "from the same source," the claim limitation, in the last line of the second subparagraph of Claim 1, refers to the records emanate "from the same given person."

This portion of Claim 1 is being amended, as the Examiner requested, to change "the same given person" to "the same source." In view of this, the Examiner is asked to reconsider and to withdraw the objection to the language of Claim 1.

In addition, for the reasons discussed below, Claims 1, 2-15 and 46 patentably distinguish over the prior art and are allowable. The Examiner is thus also asked to reconsider and to withdraw the rejections of these claims under 35 U.S.C. 103, and to allow Claims 1, 2-15 and 46.

Generally, Claims 1-15 patentably distinguish over the prior art because the prior art does not disclose or render obvious the feature, as described in Claim 1, of providing a user with a logical link to a private data set, and using that logical link to give that user access to selected data in a private data set, where that selected data enables the user to contact a given person.

As explained in detail in the present application, this invention relates to procedures for allowing a viewer of a public data set to have limited access to a related record in a private data set. In a preferred embodiment of the invention, a data record from a given person is separated into a public data record and a private data record. A logical link is created to provide access to the private data record from the public data record, and this access enables use of selected data in the private data record without providing read access to all of that private record. As part of creating this logical link, an indicator is put into the public data record and the private data record to indicate that both of these records emanated from a common source.

In the implementation of the invention, a request is received from a user, such as a merchant, to perform a predefined operation using information from the private data record. This request comprises information from the public data record and the logical link. In response to this request, the private data record is found using the information from the public data record in combination with the logical link. A predefined operation is then performed using the private data record.

This predefined operation may be, for example, sending a targeted advertisement to a person who matches a defined profile. To help implement this, the user is given access to selected data, but not to other data, in the private data set. This selected data enables the user to contact the given person, and may be, for example, the name, address, phone number, and email address of the given person.

de l'Etraz, which is the primary reference relied on to reject the claims, discloses a system for proving a contact pathway that indicates how to contact certain persons and organizations. This system includes a public information database containing data on the members of a plurality of entities in which a user has an interest in, and a private contact information database containing the personal contacts of the user. Software code is provided for accessing, in response to receiving a request from the user, the public and private databases, and this software code processes accessed information located in the databases in order to display a contact pathway.

As the Examiner has recognized, there are a number of important difference between the present invention and the procedure disclosed in de l'Etraz. For instance, with the present invention, the logical link, which links the public data record with the private data record, provides the user with limited access to some, but not all, the data in the private database. In contrast, in de l'Etraz, the user not only has read access to the private database, the user is actually the one who provides the data to that private database.

Another important difference between de l'Etraz and the present invention is that, with the present invention, the data in both the private data record and the public data record emanate from a common source – the person for whom the user is searching. In de l'Etraz, the user – not the person for whom the user is searching - provides the private data record.

These features of the present invention because they enable users, such as merchants, to use data from the private database to contact consumers while still protecting sensitive private data of the consumer, and thus maintaining the confidentiality of that sensitive data. There is no reason to maintain this confidentiality with the procedure disclosed in de l'Etraz because, as indicated above, in de l'Etraz, the user is the one who actually provides the data to the private

database. Moreover the user is ensured that the data in the private record is for the same person that the data in the private record is for.

In order to address the deficiencies of de l'Etraz as a reference, the Examiner cited Ewing for its disclosure of providing access to the private data record from a public data record.

Ewing describes a gift giving system in which persons give gifts to other persons without necessarily knowing the recipients name. In this system, referred to as a blind gift system, a request is received from a first party to take an order for a gift to be sent to second party known only by a pseudonym. Delivery of the gift can then be effected without the giver knowing the true name of that second party. As part of this process, entry of the giftee's pseudonym into a database initiates a search function; and as a result of this search, the full true name and mailing address information associated with the pseudonym is identified.

One important difference between the present invention and the procedure disclosed in Ewing is that, in the present invention, the data in the public record and the data in the private record come from the same source. Moreover, both of these records are provided with an indicator to indicate that the two records emanated from a common source.

The other references of record have been reviewed and these other references, whether considered individually or in combination, also do not disclose or suggest this feature of the present invention.

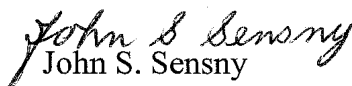
Scroggie, et al. was cited for its disclosure of using certain information including a network address, and transmitting a message to that address. This reference does not disclose or suggest, though, accessing and using private data, in the manner described above, without giving the user/requestor read access to the private database.

Independent Claim 1, which is a method claim directed to a method for accessing data records in a private data set, is being amended to describe the above-discussed feature of this invention. Specifically, Claim 1 is being amended to add the limitation that the step of creating a logical link to provide access to the private data record from the public data record includes the step of putting into the public data record and the private data record an indicator to indicate that both the private data record and the public data record emanated from the same given person.

In view of the above-discussed differences between Claim 1 and the prior art, and because of the advantages associated with those differences, claim 1 patentably distinguish over the prior art. Claims 2-15 are dependent from, and are allowable with, Claim 1. The Examiner is, accordingly, respectfully asked to reconsider and to withdraw the rejections of Claims 1-15 under 35 U.S.C. 103, and to allow these claims.

Every effort has been made to place this application in condition for allowance, a notice of which is requested. If the Examiner believes that a telephone conference with Applicants' Attorneys would be advantageous to the disposition of this case, the Examiner is asked to telephone the undersigned.

Respectfully submitted,

  
John S. Sensny  
Registration No. 28,757  
Attorney for Applicants

Scully, Scott, Murphy & Presser, P.C.  
400 Garden City Plaza – Suite 300  
Garden City, New York 11530  
(516) 742-4343

JSS:jy